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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,596	03/10/2004	Paul D. Mannheimer	009103-016220US	6350
20350	7590	01/10/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			WINAKUR, ERIC FRANK	
			ART UNIT	PAPER NUMBER
			3735	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/798,596	MANNHEIMER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric F. Winakur	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 7, 9 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-5, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 October 2005 has been entered.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed 21 October 2005 does not comply with 37 CFR 1.321(b) and/or (c) because:
- a. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).
3. It is noted that the change in power of attorney filed 5 July 2005 was not accepted for the reasons given in the Office letter mailed 25 July 2005.
4. If Applicant corrects the change in power of attorney, Applicant should re-submit a photocopy of the terminal disclaimer for re-evaluation. Alternately, a newly executed terminal disclaimer signed by an individual authorized to do so may be filed.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

6. Claims 1 - 5, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakai et al. Sakai et al. (Figure 1) teach an oximetry sensor that includes light emitters (20, 21), a light detector (25), and a memory (56) storing a first set of coefficients corresponding to a wavelength and a second set of coefficients corresponding to the wavelength (column 12, lines 6 - 21). Note, in particular, that Sakai et al. teach that the invention may be implemented with the entire table of the coefficients stored in the memory.

7. It is noted that Applicant's claims are merely directed to a subcombination (sensor) of a combination that includes the sensor and a monitor that processes signals from the sensor. Details that merely relate to how the stored values are intended to be used by the unclaimed elements of the monitor cannot serve to distinguish over the prior art. That is, they are not patentably limiting to the subcombination. The sets of coefficients stored on the memory of Sakai et al. are capable of being used in two different formulas. Further, at least one of the other values stored in the memory of Sakai et al. is capable of being used by a monitor as a value indicating a breakpoint. Lastly, the format of the formulas as recited in claims 4 and 5 do not impose structural limitations to the values stored in the memory.

***Double Patenting***

8. Claim 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,801,797 for the

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reasons of record. As noted in paragraph 2 above, the terminal disclaimer filed to overcome this rejection was not accepted.

***Response to Arguments***

9. Examiner has applied the Sakai et al. reference using certain new grounds of rejection. The rejections based on Sakai et al. above address Applicant's remarks where appropriate.

10. The rejections based upon Sperinde in view of Sakai and Kofsky in view of Sakai are withdrawn in view of applicant's amendments and remarks.

***Allowable Subject Matter***

11. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art either alone or in combination, teaches or suggests, an oximetry sensor with a memory storing first and second formulas, in combination with the other claimed elements.


12. Claims 6, 7, 9, and 10 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571/272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur  
Primary Examiner  
Art Unit 3735

6 January 2006